

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:	Atty. Docket No.:	005127.00179
Derek CAMPBELL, et al.		
Confirmation No.:	3120	
Application No.:	10/700,043	Group Art Unit: 3781
Filed:	November 4, 2003	Examiner: Mai, Tri M.
For:	GOLF BAG BASE	

**REPLY BRIEF**

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Sir:

This *Reply Brief* is filed pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer mailed July 7, 2010. Because Appellant believes that the examining corps' errors are readily ascertainable on the briefs, Appellant does not request an oral hearing at this time. However, if the Board of Patent Appeals & Interferences believes that an oral hearing would be beneficial, the Board is invited to contact Appellant's undersigned representative at (202) 824-3174.

***Remarks***

Pages 4-7 of the Examiner's Answer merely repeat the rejections in the final Office Action dated October 15, 2009, and were fully addressed in Appellant's Appeal Brief filed March 15, 2010. This Reply Brief addresses the "Response to Argument" beginning on page 8 of the Examiner's Answer.

**I. Claims 1, 4-11, 15, 16, 20-28, 33, 34, and 36 are not anticipated by Cheng '762 because Cheng '762 is not valid prior art against these claims.**

Appellants respectfully submit that Cheng ‘762 is not valid prior art against the recited claims. The filing date of the Cheng ‘762 reference is May 28, 2003. With respect to claims 1, 4-11, 15, 16, 20-28, 33, 34 and 36, Appellants rely on the Declaration of the inventors under 37 C.F.R. § 1.131 filed March 19, 2007 (a copy of which was provided in the Evidence Appendix of Appellants’ Appeal Brief), to establish a date of conception and reduction to practice prior to May 28, 2003, the filing date of the Cheng ‘762 reference. Based on the 37 C.F.R. § 1.131 Declaration of the inventors, Appellants antedate the filing date of Cheng ‘762. Accordingly, Cheng ‘762 is not prior art. Appellants respectfully request withdrawal of this rejection.

The Examiner’s Answer asserts that “the Declaration and exhibits fail to show that the bottom is made from one piece.” *See* Examiner’s Answer at p. 9-10. Appellants respectfully disagree. At least Exhibits A, and C-G illustrate a base formed of a single piece element, as recited in the claims. For instance, in Exhibit C, the phylon shell is the base. As discussed throughout the specification, additional wear elements may be affixed to the base, however, that does not alter the fact that the phylon shell base is formed of a single piece element.

The Examiner’s Answer asserts that “the [E]xaminer insists that some of the independent claims, not covered by the affidavit, are taught by Cheng ‘762.” *See* Examiner’s Answer at p. 10. Appellants respectfully disagree. As discussed in Appellants’ Appeal Brief, none of claims 1, 20, or 38 recite the reduced thickness at the interface and the shaft extending between the upper portion and the base. Accordingly, the Declaration clearly supports the features of independent claims 1, 20, and 38. No other independent claims (namely, claim 48) are rejected as being anticipated by Cheng ‘762. Thus, Appellants’ respectfully submit that the evidence presented in the Declaration is sufficient to establish a date of conception and reduction to practice prior to May 28, 2003, the filing date of Cheng ‘762. Cheng ‘762 is therefore not valid as prior art against the present claims, and Appellants respectfully request withdrawal of these rejections.

## **II. Cheng ‘362 fails to teach or suggest the features of claims 1, 6, 8-11, 15, 16, 18, 20-25, 33, and 34.**

The Examiner’s Answer asserts, at p. 10, that “Cheng ‘362 clearly teaches a one piece base with a pivot section 40 is molded together with the base,” and cites to col. 3, lines 11-20 of Cheng ‘362. However, Appellants respectfully disagree. At most, Cheng ‘362 describes a one

piece *pivot section* connecting two portions of the base. There is no teaching or suggestion in Cheng '362 of a base formed of a single piece element, as recited in the claims.

The Examiner's Answer asserts, at p. 11, that the "[E]xaminer submits that Cheng ['362] teaches a plurality of embodiments other than the anticipated embodiment where the flexible pivot section is molded together with the two halves as set forth above." The Examiner's Answer fails to identify these other embodiments and Appellants submit that none of these other embodiments teaches or suggests a base formed of a single piece element, as recited.

The Examiner's Answer further asserts, at p. 12, that the "recitation 'single piece element' must be interpreted as 'a one-piece item' which is comprised of a plurality of elements as set forth in the specification." Appellants respectfully disagree. Although portions of the specification recite wear elements that may be affixed to the base, the base is formed of a single piece element. This one piece base is described throughout the originally filed specification, claims and figures and, at least at paragraphs [01], [05], and [29].

The Examiner's Answer, at p. 11, cites to one portion of one paragraph of the specification and asserts that that sentence defines a base. Appellants respectfully disagree. The cited sentence (at para. 37) of the specification is merely one configuration and in no way defines the term base for the specification. Rather, there are several instances, as recited above, where the base is clearly described as being one piece. The inclusion of Keller and assertion that the one piece collar of Keller is formed of multiple parts has no bearing on the single piece base as recited in the claims. Accordingly, Appellants submit that the claims are patentably distinct from Cheng '362.

### **III. Te-Pin fails to teach or suggest the features of claims 1, 4-11, 15, 16, 18, 20-28, 33, 34 and 36.**

The Examiner's Answer asserts, at p. 12, that "Te-Pin teaches a front section 11, a rear section 20 and a flexible section 50 joined [by] the two sections forming a 'single piece' as claimed." Appellants respectfully disagree.

As discussed in Appellants' Appeal Brief, Te-Pin describes a golf bag that includes a base bracket. Col. 2, lines 48-49. The base bracket includes a front section, a rear section, a first flexible section disposed on the front section, a second flexible section disposed on the rear section and a connecting member connected between the first and second flexible sections. *See*

Col. 2, lines 57-61 and FIGS. 1, 2, 4 and 5. The connecting member is disposed between the first and second flexible sections and is connected with outer edges of corresponding portions thereof. Col. 3, lines 33-35. A part of the connecting member is connected with the first and second flexible sections on the bottom of the base bracket, while another part is connected with the first and second flexible sections on the lateral side of the base seat. Col. 3, lines 35-40. The first and second sections are “connected together to form a larger receiving space.” Col. 3, lines 40-41.

Clearly, Te-Pin fails to teach or suggest a base formed of a single piece element that extends substantially around the second end of the body. In fact, Te-Pin describes a base including multiple parts connected together. For instance, the connecting member of Te-Pin is “bridged and connected between the first and second flexible sections by way of stitching.” Col. 4, lines 15-17. Note also Figs. 2, 4 and 5 of Te-Pin. As such, Te-Pin specifically teaches away from a base formed of a single piece element that extends substantially around the second end of the body, as recited in claims 1 and 20. Accordingly, Appellants respectfully request withdrawal of these rejections.

**IV. None of Kang, Wen-Chien, or Yoshida cures the deficiencies of Cheng ‘762, Cheng ‘362 or Te-Pin.**

With respect to issues D, E, and F, as identified in the Examiner’s Answer, none of Kang, Wen-Chien, or Yoshida, either alone or in combination, cures the above-identified deficiencies of Cheng ‘762, Cheng ‘362 or Te-Pin.

**V. None of Cheng ‘762, Cheng ‘362, Te-Pin, Wen-Chien or Kang, alone or in combination, teaches or suggests the features of claims 48-55.**

As discussed in Appellants’ Appeal Brief, independent claim 48 recites, among other features, a golf bag comprising:

a base secured to an end of the body, the base having a foam element formed of a polymer foam material, and the base having at least a first wear element and a second wear element secured to an exterior surface of the foam element, wherein *the first wear element has a first configuration and the second wear element has a second configuration, the second configuration being different from the first configuration* and wherein at least one of the first and second wear elements is configured to contact a ground.

None of the Cheng references or Te-Pin teaches or suggests the features of claim 48. For example, none of the Cheng references or Te-Pin teaches or suggests at least a first and second wear element. The addition of Wen-Chien and Kang fails to cure the deficiencies of the Cheng references or Te-Pin with respect to claim 48. None of the cited references, alone or in combination, teaches or suggests a first wear element and a second wear element having different configurations. Accordingly, Applicants respectfully submit that claim 48 is allowable over the cited combination of references.

### **CONCLUSION**

Appellants believe that the above reasoning presents the clearest arguments for overturning the rejection. For all the foregoing reasons, and based on the previously submitted arguments, Appellants respectfully request that the Board instruct the examining corps to withdraw the rejections and pass this case to issuance at its earliest convenience. If there are any questions or any additional information is required, please contact Appellants' undersigned representative at (202) 824-3174.

Respectfully submitted,  
**BANNER & WITCOFF, LTD.**

Date: September 7, 2010

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